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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/622,524

07/18/2003

Raymond A. Hui

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03/07/2006

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EXAMINER

CEPERLEY, MARY

ART UNIT

PAPER NUMBER

1641

DATE MAILED: 03/07/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/622,524

Applicant(s)

HUI ET AL.

Examiner

Mary (Molly) E. Ceperley

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1641

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 19 December 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-3, 5, 10, 11, 13, 14, 16-33 and 36 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 5, 10, 11, 13, 14, 24, 25 and 30 is/are allowed.
- 6) ☒ Claim(s) 1-3, 16-23, 26-29, 31-33 and 36 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

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1) The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

2) Claims 1-3, 22, 23, 29, 31-33 and 36 are rejected under 35 U.S.C. 102(b) as being anticipated by Huber et al (US 5,976,812) for the reasons of record as stated in paragraph **14)** of the June 24, 2005 Office action.

Specifically, Huber et al describe the compounds of claim 1 of this application wherein the variable "R¹" is ethyl, "R²" is hydrogen and "R³" is methyl, "L" contains a carbon atom directly linked to the phenyl ring, and "Q" is a "macromolecular carrier" or "label". See the claim 8 and 12 compounds of Huber et al wherein "R¹", "R²" are hydrogen, "R³" is methyl, "L" is " $-(\text{CH}_2)_{2-6}\text{-NH-C(O)-})_{1-2}-(\text{CH}_2)_{2-10}\text{-X-}$ ", "r" = 0, "P" is "an enzyme" or "a dye" {note that "P" can also be an immunogenic carrier: see col. 3, line 63 – col. 4, line 2}. The thio-derivatized maleimide moiety attached to "L" in claim 8 of Huber et al is encompassed by the "L-X" definition of claim 1 of this application wherein "L comprises 1-15 carbon atoms, one of which is directly linked to the phenyl ring and 0-6 heteroatoms" and wherein "X" is defined as "-S-".

Applicant's arguments filed December 19, 2005 have been fully considered but they are not persuasive for the reason that the maleimide group of the structure of claim 1, argued by applicants not be "a leaving group" {which term has been deleted from claim 1} is still encompassed by the "L-X" definition as described in the above paragraph. The "L" definition of claim 1 of this application, which is inclusive of heterocyclic structures, does not exclude the thio-derivatized maleimide moiety of the Huber et al compounds.

3) Claims 16-21 and 26-28 are rejected under 35 U.S.C. 102(b)/103(a) as being anticipated by or obvious over Huber 35 L (US 5,976,812) for the reasons stated in paragraph **15)** of the June 24, 2005 Office action.

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Since the same immunogens are used in this application and in the Huber et al patent as described in **2)** above, it must be presumed that the antibodies resulting from the use of the same immunogens would have the same or similar cross-reactivities, i.e. cross-reactivities as described in claims 16-21.

Applicant's arguments filed December 19, 2005 have been fully considered but they are not persuasive. "Removing a portion of the MDEA molecule, i.e., the methylene dioxy moiety, and then making a substitution off the benzene ring and adding a single carbon off the benzeze nitrogen (going from a methyl to an ethyl group)" results in compounds which are also described by Huber et al (see the discussion of paragraph **2)** above).

4) Claims 5, 10, 11, 13, 14, 24, 25 and 30 are allowed.

5) THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.


6) Any inquiry concerning this communication or earlier communications from the examiner should be directed to Mary (Molly) E. Ceperley whose telephone number is (571) 272-0813. The examiner can normally be reached from 8:30 a.m. to 5:00 p.m.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Long V. Le, can be reached on (571) 272-0823. The fax phone number for the organization where this application or proceeding is assigned is (571) 273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

March 02, 2006


Mary (Molly) E. Ceperley
Primary Examiner
Art Unit 1641